

## BEST AVAILABLE COPY

### REMARKS

The allowance of claims 5-9 and 16-23 is acknowledged. Further, the indication that claims 2, 4 and 12 are objected as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is acknowledged. By the present amendment, claims 2 and 4 have been written in independent form, while claim 12 has been retained in dependent form, since parent claim 10 has been amended as will be discussed below. Thus, applicants submit that at least claims 2 and 4 and the dependent claims thereof should now be in condition for allowance.

With respect to the objection to the specification, applicants note that the informality referred to in the original specification has been corrected in the Substitute Specification which the Examiner has indicated by telephone has been entered. However, informalities in the Substitute Specification have been corrected herein.

Also, submitted herewith are corrected drawings.

With respect to the Examiner's contention concerning an Information Disclosure Statement, applicants note that the listing as provided in the specification represents a listing under 37 CFR 1.56, such that applicants do not consider the same to be an Information Disclosure Statement under 37 CFR 1.98.

By the present amendment, independent claim 1 has been canceled without prejudice or disclaimer of the subject matter thereof, with objected to claims 2 and 4 being written in independent form so that these claims should now be in condition for allowance. Additionally, claim 3 has been amended to depend from claim 2, such that this claim should be considered allowable with its parent claim. Furthermore, independent claims 10, 13, 24, 27 and 28 have been amended to recite further features of the present invention, which patentably distinguish over the cited art as

will be discussed below and dependent claims 25 and 26 have been amended to conform to the language of parent claim 24.

The rejection of claims 1, 3, 10, 11, 13-15 and 24-28 under 35 U.S.C. 103(a) as being unpatentable over Karpol et al (US006369888B1) is traversed insofar as it is applicable to the present claims, and reconsideration and withdrawal of the rejection are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual

question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Turning first to independent claim 10, this claim has been amended to recite irradiating means for irradiating the sample with the ultraviolet laser beam whose coherence was reduced by said coherence reducing means through a polarizing beam splitter and an objective lens. As described in connection with Fig. 1 of the drawings of this application at page 17 of the Substitute Specification, numeral 5 denotes a polarizing beam splitter, which is constructed so as to reflect the illumination light from the illuminating light source 3, make it pass through the objective lens 7, and perform bright field illumination on the semiconductor wafer. It is noted that Fig. 13 illustrates a polarizing beam splitter 131 and describes the operation at pages 27 and 28 of the Substitute Specification. Applicants note that while Karpol et al in Fig. 1A thereof discloses the utilization of a beam splitter 8 in the path of the beams emitted by the light source 4 via an optical system 6, a beam splitter 8 and an objective lens 10 onto the surface of the article 1 while further describing beam splitters 24 and 28, there is no disclosure or teaching of a polarizing beam splitter and arranged in the manner defined in claim 10 and the dependent claims thereof, such that applicants submit that claim 10, as amended, patentably distinguishes over Karpol et al in the sense of 35 U.S.C. 103 and should be considered allowable thereover together with its dependent claims.

Applicants note that objected to claim 12 depends from claim 10 and should be considered allowable therewith and likewise, dependent claim 11 should be considered allowable with parent claim 10.

## BEST AVAILABLE COPY

Applicants note that both independent claims 27 and 28 directed to the method have been amended to recite the feature of a polarizing beam splitter in which a sample or wafer is irradiated with light through a polarizing beam splitter, while also reciting the feature of detecting an image of a sample or circuit pattern which was irradiated with light or the like through the polarizing beam splitter. As pointed out above, there is no disclosure or teaching in Karpol et al in the sense of 35 U.S.C. 103 of the recited features of claims 27 and 28, as amended, such that applicants submit that these claims also patentably distinguish over the cited art and should now be in condition for allowance.

With respect to independent claims 13 and 24, which claims are directed to the method, such claims have been amended to recite the feature of reducing coherence of the laser beam by effecting scanning of the laser beam with a coherence reducing means. Applicants note that the Examiner has recognized at least with respect to the scanning feature for reducing coherence that this feature is not disclosed or taught by Karpol et al. That is, as indicated in the statement of reasons for indication of allowable subject matter, "scanning of an ultraviolet laser beam which has had its coherence reduced over a pupil is not suggested". While Karpol et al, as recognized by the Examiner, describes different embodiments of a coherence reduction optical apparatus 30, there is no disclosure or teaching of reducing coherence by scanning of the beam in the manner recited. Thus, applicants submit that independent claims 13 and 24 and the dependent claims thereof also patentably distinguish over Karpol et al in the sense of 35 U.S.C. 103 and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (501.38036X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



Melvin Kraus

Registration No. 22,466

ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/cee  
(703) 312-6600

**BEST AVAILABLE COPY**